

REMARKS

Claims 42, 44-50, and 52-55 were pending in the application; the status of the claims is as follows:

Claims 42, and 44-49 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,737,014 to Tojo et al (“Tojo”).

Claims 50, and 52-55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tojo in view of U.S. Patent No. 4,709,385 to Pfeiler et al (“Pfeiler”).

Claims 42, and 44-49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,162,833 to Taka (“Taka”) in view of U.S. Patent No. 5,034,804 to Sasaki et al (“Sasaki”).

Claims 50, and 52-55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Taka in view of Sasaki and Pfeiler.

Claims 42, and 44-49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,897,732 to Konishita et al (“Konishita”) in view of U.S. Patent No. 5,067,029 to Takahashi (“Takahashi”).

Claims 50, and 52-55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Konishita in view of Takahashi and Pfeiler.

Claims 42, 47, 50 and 54 have been amended to more clearly describe the invention. These changes do not introduce any new matter.

Claims 45 and 53 have been cancelled.

Application No. 09/768,667
Amendment dated December 1, 2004
Reply to Office Action of June 16, 2004

35 U.S.C. § 102(e) Rejection

The rejection of claims 42, and 44-49 under 35 U.S.C. § 102(e) as being anticipated by Tojo, is respectfully traversed based on the following.

The Office Action describes Tojo has disclosing “a first storing means (20)” and “a second memory (7)”. The Office Action further describes Tojo as teaching that “the first memory is detachable and [the] second memory is fixed since the second memory is inserted into the connection fixed in the camera.”

The “second memory (7)” referenced by the Office Action is frame memory 7, which is contained in memory unit 27. Tojo discloses that “memory unit 27 is made attachable to and detachable from the imager 1.” (Tojo, col. 3, line 65 through col. 4, line 1). Thus, Tojo does not disclose that the second memory (frame memory 7 or memory unit 27) is fixedly installed inside a camera body. In fact, both the first and second memories of Tojo are detachable from the imager 1.

Claim 42 recites, *inter alia*,

a second memory, fixedly installed inside the camera body, capable of storing image information corresponding to a plurality of photographic frames;

Thus, claim 42 requires that the second memory be fixedly installed inside the camera body. Tojo does not disclose that the second memory is fixedly installed inside the camera body and therefore cannot anticipate claim 42. Claims 44 and 46 depend from and include all the limitations of claim 42 and thus are allowable for at least the same reasons.

Application No. 09/768,667
Amendment dated December 1, 2004
Reply to Office Action of June 16, 2004

Claim 47 recites, *inter alia*,

a second connection electrically connectable to a second recording medium, fixedly mounted inside the camera body, capable of storing image information corresponding to a plurality of photographic frames;

Thus, claim 47 requires that the second recording medium be fixedly mounted inside the camera body. Tojo does not disclose this feature of the invention and therefore cannot anticipate claim 47. Claims 48 and 49 depend from and include all the limitations of claim 47 and thus are allowable for at least the same reasons.

Claim 45 has been cancelled. Thus the rejection of claim 45 is moot.

Accordingly, it is respectfully requested that the rejection of claims 42, 44 and 46-49 under 35 U.S.C. § 102(e) as being anticipated by Tojo, be reconsidered and withdrawn.

35 U.S.C. § 103(a) Rejections

The rejection of claims 50, and 52-55 under 35 U.S.C. § 103(a), as being unpatentable over Tojo in view of Pfeiler, is respectfully traversed based on the following.

The Office Action admits that Tojo does not teach “the use of a buffer memory for storing the image from the first memory or [the] second memory,” and cites Pfeiler for disclosing a memory that receives images from one of two memories. (Office Action, pp. 4-5).

Tojo is directed to an electronic camera, suitable for use by, for example, a tourist. (Tojo: col. 2, lines 1-4). Pfeiler discloses an x-ray diagnostic installation for subtraction angiography. (Pfeiler: abstract). Since Tojo and Pfeiler are directed to entirely different types of devices, a camera suitable for use by a tourist (Tojo) and an x-ray angiography device (Pfeiler), there is no suggestion or motivation to combine the teachings of Tojo

with that of Pfeiler. Nor can there be any expectation of success from combining the teachings of a conventional camera with that of an x-ray device.

Further, even if Tojo and Pfeiler were to be combined, Pfeiler fails to rectify the deficiencies of Tojo in that Pfeiler also does not disclose a device in which one memory is detachably mounted inside the camera body, while the second memory is fixedly mounted inside the camera body.

Claim 50 recites, *inter alia*,

a first memory, detachably mountable inside the camera body and capable of storing image information corresponding to at least two photographic frames;

a second memory, fixedly mounted inside the camera body and capable of storing image information;

Thus, claim 50 requires that the first memory be detachably mountable inside the camera body while the second memory be fixedly mounted inside the camera body.

Neither Tojo nor Pfeiler disclose these features of the invention. Thus, even if Tojo and Pfeiler could be combined (and there is no suggestions or motivation to do so) claim 50 would still not be obvious over Tojo and Pfeiler. Claim 52 depends from and contains all the limitations of claim 50 and thus is patentable over Tojo and Pfeiler for at least the same reasons.

Claim 54 recites, *inter alia*,

a first connection electrically connectable to a first recording medium, detachably mountable inside the camera body and capable of storing image information corresponding to a plurality of photographic frames;

a second connection electrically connectable to a second recording medium, fixedly mounted inside the camera body and capable of storing image information;

Application No. 09/768,667
Amendment dated December 1, 2004
Reply to Office Action of June 16, 2004

Thus, claim 54 requires that the first recording medium be detachably mountable inside the camera body while the second recording medium be fixedly mounted inside the camera body. As discussed above, neither Tojo nor Pfeiler disclose these features of the invention. Thus, even if Tojo and Pfeiler could be combined (and, as discussed above, there is no suggestions or motivation to do so) claim 54 would still not be obvious over Tojo and Pfeiler. Claim 55 depends from and contain all the limitations of claim 54 and thus is patentable over Tojo and Pfeiler for at least the same reasons.

Claim 53 has been cancelled. Thus the rejection of claim 53 is moot.

Accordingly, it is respectfully requested that the rejection of claims 50, 52, and 54-55 under 35 U.S.C. § 103(a) as being unpatentable over Tojo in view of Pfeiler, be reconsidered and withdrawn.

The rejection of claims 42, and 44-49 under 35 U.S.C. § 103(a), as being unpatentable over Taka in view of Sasaki, is respectfully traversed based on the following.

Taka discloses a camera having a recall memory 10 and a special memory 12. A D/A converter 14 receives the data of one image plane read out of either one of the moving image, recall and special memories 8, 10 and 12 and produces a corresponding analog signal. A display drive circuit 16 receives the analog output from the D/A converter 14 and converts it to a signal for driving an image display device 18. (Taka, col. 3, line 53 through col. 4, line 3).

The Office Action admits that, in Taka, “the first memory and second memory are installed in the camera body” but cites Sasaki for teaching a detachable memory. However, there is no motivation or suggestion in Taka to replace one of the recall or special memory with the detachable memory of Sasaki. If, as the Office Action indicates, it is desirable to replace the first memory of Taka with the detachable memory of Sasaki “in order to easily replace or use or reuse the first memory when needed” it would be just as desirable to replace the second memory with the detachable memory. Of course,

Application No. 09/768,667
Amendment dated December 1, 2004
Reply to Office Action of June 16, 2004

replacing both the first and second memories with detachable memories would simply result in a system analogous to that of Tojo.

Thus, claim 42 is not obvious over Taka and Sasaki. Claims 44 and 46 depend from and include all the limitations of claim 42 and thus are allowable for at least the same reasons.

Likewise, claim 47 is also not obvious over Taka and Sasaki. Claims 48 and 49 depend from and include all the limitations of claim 47 and thus are allowable for at least the same reasons.

Accordingly, it is respectfully requested that the rejection of claims 42, 44 and 46-49 under 35 U.S.C. § 103(a) as being unpatentable over Taka in view of Sasaki, be reconsidered and withdrawn.

The rejection of claims 50, and 52-55 under 35 U.S.C. § 103(a), as being unpatentable over Taka in view of Sasaki and Pfeiler, is respectfully traversed based on the following.

As discussed above, there is no suggestion or motivation to combine Taka with Sasaki. Further, as discussed above, Pfeiler is not even directed to a camera, but rather, is directed to a x-ray diagnostic system. Thus, there is no suggestion or motivation to combine Taka with Sasaki and Pfeiler.

As discussed above, claim 50 requires that the first memory be detachably mountable inside the camera body while the second memory be fixedly mounted inside the camera body. Further, as discussed above, neither Taka, Sasaki or Pfeiler disclose a system in which the first memory is detachably mountable inside the camera body while the second memory is fixedly mounted inside the camera body. Thus claim 50 is not obvious over Taka, Sasaki and Pfeiler. Claim 52 depends from and contain all the

Application No. 09/768,667
Amendment dated December 1, 2004
Reply to Office Action of June 16, 2004

limitations of claim 50 and thus is patentable over Tojo, Sasaki and Pfeiler for at least the same reasons.

Further, as discussed above, claim 54 requires that the first recording medium be detachably mountable inside the camera body while the second recording medium be fixedly mounted inside the camera body. Neither Taka, Sasaki or Pfeiler disclose a system in which the first recording medium is detachably mountable inside the camera body while the second recording medium is fixedly mounted inside the camera body. Thus claim 54 is not obvious over Taka, Sasaki and Pfeiler. Claim 55 depends from and contain all the limitations of claim 54 and thus is patentable over Tojo, Sasaki and Pfeiler for at least the same reasons.

Accordingly, it is respectfully requested that the rejection of claims 50, and 52-55 under 35 U.S.C. § 103(a) as being unpatentable over Taka in view of Sasaki and Pfeiler, be reconsidered and withdrawn.

The rejection of claims 42, and 44-49 under 35 U.S.C. § 103(a), as being unpatentable over Konishita in view of Takahashi, is respectfully traversed based on the following.

The Office Action cites Konishita as teaching “that the first memory is detachable and [that the] second memory is fixed.” However, the Office Action admits that “Konishita fails to specifically teach that the first memory is installed inside the body of the camera.” The Office Action then seeks to add the teachings of Takahashi “to arrange the first memory to be detachable and is inside the body of the camera as an alternative arrangement of the first memory for the camera.” (Office Action, pages 8-9).

However, there is no motivation or suggestion to combine the teachings of Konishita with that of Takahashi. In fact, placing the first memory of Konishita inside the body of the camera (in accordance with Takahashi) goes against the teachings of

Application No. 09/768,667
Amendment dated December 1, 2004
Reply to Office Action of June 16, 2004

Konishita, that is, to allow miniturization of the camera. (Kinoshita, col. 1, lines 33-35). Implementing the first memory internal to the camera would only make the camera larger.

As discussed above, claim 42 requires that the second memory be fixedly installed inside the camera body. The Office Action acknowledges that Konishita fails to disclose this feature. Adding the teachings of Takahashi would simply result in one of the drawbacks that Konishita is trying to solve. Thus, claim 42 is not obvious over Konishita and Takahashi. Claims 44 and 46 depend from and include all the limitations of claim 42 and thus are allowable for at least the same reasons.

Further, as discussed above, claim 47 requires that the second recording medium be fixedly mounted inside the camera body. Konishita fails to disclose this feature, and adding the teachings of Takahashi would simply result in one of the drawbacks that Konishita is trying to solve. Thus, claim 47 is not obvious over Konishita and Takahashi. Claims 48 and 49 depend from and include all the limitations of claim 47 and thus are allowable for at least the same reasons.

Accordingly, it is respectfully requested that the rejection of claims 42, and 44-49 under 35 U.S.C. § 103(a) as being unpatentable over Konishita in view of Takahashi, be reconsidered and withdrawn.

The rejection of claims 50, and 52-55 under 35 U.S.C. § 103(a), as being unpatentable over Konishita in view of Takahashi and Pfeiler, is respectfully traversed based on the following.

As discussed above, there is no suggestion or motivation to combine Konishita with Takahashi. Further, as discussed above, Pfeiler is not even directed to a camera, but rather, is directed to a x-ray diagnostic system. Thus, there is no suggestion or motivation to combine Konishita with Takahashi and Pfeiler.

As discussed above, claim 50 requires that the first memory be detachably mountable inside the camera body while the second memory be fixedly mounted inside the camera body. Further, as discussed above, neither Konishita, Takahashi nor Pfeiler disclose a system in which the first memory is detachably mountable inside the camera body while the second memory is fixedly mounted inside the camera body. Thus claim 50 is not obvious over Konishita, Takahashi and Pfeiler. Claim 52 depends from and contain all the limitations of claim 50 and thus is patentable over Konishita, Takahashi and Pfeiler for at least the same reasons.

Further, as discussed above, claim 54 requires that the first recording medium be detachably mountable inside the camera body while the second recording medium be fixedly mounted inside the camera body. Neither Konishita, Takahashi or Pfeiler disclose a system in which the first recording medium is detachably mountable inside the camera body while the second recording medium is fixedly mounted inside the camera body. Thus claim 54 is not obvious over Konishita, Takahashi and Pfeiler. Claim 55 depends from and contain all the limitations of claim 54 and thus is patentable over Konishita, Takahashi and Pfeiler for at least the same reasons.

Accordingly, it is respectfully requested that the rejection of claims 50, and 52-55 under 35 U.S.C. § 103(a) as being unpatentable over Konishita in view of Takahashi and Pfeilert, be reconsidered and withdrawn.

CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a

Application No. 09/768,667
Amendment dated December 1, 2004
Reply to Office Action of June 16, 2004

fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

Any fee required by this document other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

By: 

Tung T. Nguyen
Registration No. 42,935
Attorney for Applicants

TTN/lb:jjk:bar
SIDLEY AUSTIN BROWN & WOOD LLP
717 N. Harwood, Suite 3400
Dallas, Texas 75201
Direct: (214) 981-3478
Main: (214) 981-3300
Facsimile: (214) 981-3400
December 1, 2004